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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,036	06/22/2005	Josef Ehrenfreund	70175	8850

26748 7590 09/19/2006

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EXAMINER

KOSACK, JOSEPH R

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/540,036	Applicant(s) EHRENFREUND ET AL.	
	Examiner Joseph Kosack	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 1-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/22/05, 8/29/05, 8/31/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-12 are pending in the instant application.

Election/Restrictions

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Due to the numerous variables in the claims, e.g. R¹, R², R³, R⁴, Het, etc... and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

Group I, claim(s) 1-8 (in part) and 11 (in part), drawn to compounds of Formula I wherein Het is 1,2-diazole attached to the main structure in the 4-position.

Group II, claim(s) 1-8 (in part) and 11 (in part), drawn to compounds of Formula I wherein Het is pyrrole attached to the main structure in the 3-position.

Group III, claim(s) 1-8 (in part) and 11 (in part), drawn to compounds of Formula I wherein Het is thiazole attached to the main structure in the 5-position.

Group IV, claim(s) 9, drawn to compounds of Formula II.

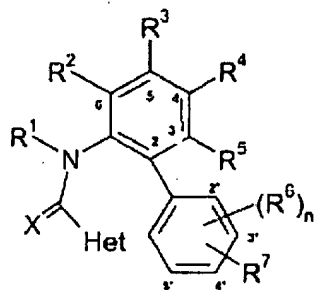
Group V, claim(s) 10, drawn to compounds of Formula III.

Group VI, claim(s) 12 (in part), drawn to a method of using a compound of Formula I wherein Het is 1,2-diazole attached to the main structure in the 4-position.

Group VII, claim(s) 12 (in part), drawn to a method of using a compound of Formula I wherein Het is pyrrole attached to the main structure in the 3-position.

Group VIII, claim(s) 12 (in part), drawn to a method of using a compound of Formula I wherein Het is thiazole attached to the main structure in the 5-position.

In accordance with 37 CFR 1.499, Applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, **this list is not exhausted**, as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, Applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and Examiner will endeavor to group the same. **If Applicant is unable to elect a single invention, Applicant may instead choose to elect a specific compound and Examiner will attempt to group it.** The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain



, which does not define a contribution over the prior art (see US

PGPUB 2002/0123515 A1). The substituents vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered proper. Additionally, the vastness of the claimed subject matter and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter. The method of preparation claims will be examined with the elected invention commensurate in scope therewith.

Response to Restriction

During a telephone conversation with Thomas Hamilton on August 29, 2006 a provisional election was made **with** traverse to prosecute Inventions I and VI, claims 1-8 (in part) and 11-12 (in part). Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 (in part), 9-10, and 11-12 (in part) withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

The claim to priority as a 371 filing of PCT/EP03/14248 filed December 15, 2003 which claims priority to UK 0230155.4 filed December 24, 2002 has been granted in the instant application.

Information Disclosure Statement

The Information Disclosure Statements filed on June 22, 2005; August 29, 2005; and August 31, 2006 have been considered by the Examiner. The Examiner would like to bring to Applicant's attention that some foreign patent documents have **not** been considered as a complete copy of the reference has not been submitted to the office with the Information Disclosure Statement. These references are crossed out on the copies enclosed herewith. Applicant is encouraged to file the complete documents along with a new Information Disclosure Statement in the reply to this action to ensure consideration of these documents in the instant application.

Claim Objections

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Claims 1-8 and 11-12 are objected to for containing elected and non-elected subject matter. The elected subject matter have been identified supra.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-12 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

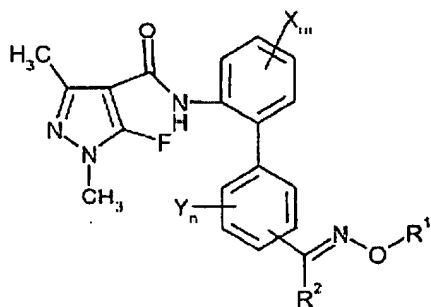
In the instant application, compositions for controlling microorganisms and preventing attack and infestation of plants and a method of controlling or preventing infestation of cultivated plants by phytopathogenic microorganisms are claimed. The specification only provides firm support for the compounds of claim 1 to control fungal infections in plants. The examples cite that infestation is prevented virtually completely (0-5%), but there is no showing that full prevention can be accomplished by application of the compounds, i.e. 0% infestation. Also, the compounds have only been tested against fungi, and not bacteria, amoebae, etc.. that would fall under the genus of microorganisms. Therefore, claims 11-12 fail to meet the written description requirement of 35 U.S.C. 112, first paragraph, as a person of skill in the art would not conclude that the Applicant was not in possession of the full invention as claimed.

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Applicant is encouraged to limit the claims to those elements that have full written description support to overcome the rejection, or to cancel the claims.

Closest Prior Art

A search of the prior art has yielded no references that anticipate or adequately suggest the instant compounds. The closest prior art is that of Elbe et al. (WO 02/08195 A1) that teaches compounds of the formula:



with substitutions as defined.

Conclusion

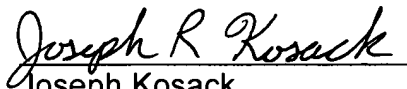
Claims 11-12 are rejected. Claims 1-8 and 11-12 are objected to. All claims are free of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Kosack whose telephone number is (571)-272-5575. The examiner can normally be reached on M-F 5:30 A.M. until 2:00 P.M.

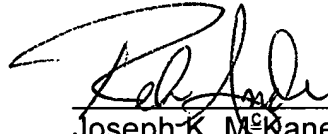
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph Kosack
Patent Examiner
Art Unit 1626



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626